

Application No. 09/444,356
Paper Dated September 22, 2004
In Reply to USPTO Correspondence of March 22, 2004
Attorney Docket No. 2138-991562

REMARKS

The Office Action of March 22, 2004 has been reviewed, and the Examiner's comments carefully considered.

Claims 1-4, 6-12, 18, and 26-34 are currently pending in this application. Claims 2-3, 30, and 33-34 have been canceled. Claims 1, 10, 26, 28, 31-32 have been amended to distinguish further over the prior art. Claim 4 has been amended to properly depend from amended claim 1. Additionally, new claims 35-37 have been added. Therefore, claims 1, 4, 6-12, 18, and 26-29, 31-32, and 35-37 remain in this application. Support for all amendments to the claims can be found in the specification and drawings as originally filed. No new subject matter is believed to have been added by this amendment.

35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1-4, 6-12, 18, and 26-34 under 35 U.S.C. § 103(a) as being unpatentable over Sonesh and Lacombe in view of U.S. Patent No. 6,526,158 to Goldberg (hereinafter "the Goldberg patent"). In view of the amended claims, attached declarations, as discussed in detail hereinafter, and the following remarks, the Applicant respectfully requests reconsideration of these rejections.

The Goldberg patent has been used as an obviousness reference in all of the rejections by the Examiner. It is noted that the underlying PCT application of the Goldberg patent was filed September 3, 1997, which is before November 29, 2000 (the date on which the new 102(e) rule took effect). Hence, the 102(e) date for the Goldberg patent is the 371(c)(1),(2),(4) date, which is February 26, 1999. Furthermore, the effective date of the underlying PCT application of the Goldberg patent is the WIPO publication date, as the PCT application was filed before November 29, 2000. Thus, the Goldberg patent does not have an effective 102(e) date in this case and becomes prior art only under §102(a) as of March 12, 1998, the date of its PCT publication. The Examiner did not cite the published PCT application but rather cited the ineffective U.S. patent. Applicant's priority filing date is November 18, 1998.

Anticipating that the Examiner may subsequently cite the published Goldberg PCT application, attached hereto and incorporated herein by reference is a *Declaration Under*

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37 C.F.R. § 1.131 Showing Conception And Diligence Prior To March 12, 1998 Until November 18, 1998, executed by Mr. David P. Catanoso (hereinafter "the *Catanoso Declaration*"). Mr. Catanoso is the named inventor of the invention described and claimed in the present application. *Catanoso Declaration* ¶ 1. The provisional application, to which the present application claims priority, was filed in the United States Patent and Trademark Office on November 18, 1998. *Catanoso Declaration* ¶ 4.

Mr. Catanoso conceived the present invention during the summer of 1997 and memorialized the present invention in drawings in early August 1997. *Catanoso Declaration* ¶ 2; Exhibit 1. During the course of the fall of 1997, Mr. Catanoso researched commercially available components that could be used to build an initial prototype of the system to support final design and software development. In early 1998, he began purchasing the necessary components and writing the necessary software for the system. By June of 1998, he completed the production version of the software and built a production version of the system for installation on a ride called "The Rocket", located at the Dinosaur Beach amusement park in Wildwood, NJ. The system went into operation on the ride producing videos for sale in July of 1998. In the fall of 1998, Mr. Catanoso contacted patent counsel, namely Webb Ziesenheim Logsdon Orkin & Hanson P.C. (The Webb Law Firm), to procure patent protection for the present invention. Subsequently, United States Provisional Application No. 60/108,906, directed to the subject matter of the present invention, was filed on November 18, 1998 in the United States Patent and Trademark Office. *Catanoso Declaration* ¶¶ 2 & 4.

The provisional application was filed on November 18, 1998, and Mr. Catanoso declares that this invention was not sold or in public use in the United States for one year prior to the date of the provisional application, nor was it patented or described in a printed publication anywhere prior to that time. In addition, the invention was never abandoned. *Catanoso Declaration* ¶ 6. Therefore, this activity prior to the March 12, 1998 effective date of the PCT application underlying the Goldberg patent until November 18, 1998, which is the effective filing date of the United States provisional patent application, demonstrates the required evidence of conception and diligence from before March 12, 1998 until November 18, 1998. *Catanoso Declaration* ¶¶ 5 & 7.

Accordingly, the invention underlying the present application was conceived prior to the effective date of the PCT application underlying the Goldberg patent, and the

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present invention was diligently reduced to practice through the November 18, 1998 filing date of the present application. Therefore, the Goldberg patent (and its PCT application) do not represent prior art and should be withdrawn from consideration.

In the present application, further amended claims 1 and 28 are in independent form. Further, with the withdrawal of the Goldberg patent as a prior art reference (including the corresponding PCT application) to the present invention, independent claims 1 and 28 are not anticipated by or rendered obvious over the Sonesh patent, the LaCombe patent, or any of the other prior art of record, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as now claimed, obvious.

The Applicant has amended the claims as follows. Claim 1 now includes the limitation of at least two video sources, whose image output into the capture workstation is determined by programmable logic controllers (PLC) responsive to signals received from sensors in communication with the amusement ride (Support found on page 4, lines 3-9; and page 10, lines 6-19). The Applicant would like to point out that PLCs allow for complex logic scenarios involving many sensors and/or many output devices to be controlled. The use of a PLC allows for the offloading of some of the computational load from the main capture workstation to the PLC. The PLC running software customized for the given amusement ride can summarize results and provide a concise sensor reading to the workstation. In addition, the PLC can react to sensor inputs and trigger output devices on its own with little or no modifications to the core software system running on the workstation(s). This allows for a cost effective way to adapt the system to a variety of amusement rides without having to provide access to or modify the core software. None of the prior art of record utilizes PLCs in conjunction with sensors in communication with the amusement ride to determine what images to deliver to a capture workstation.

Claim 10 defines the type of censoring functions available to the censor workstation (Support found on page 5, lines 10-13 of the specification). Claim 28 adds the limitation of capturing video sequences (as opposed to still frames) and then wirelessly transmitting those sequences to the capture workstation and displaying them to patrons in response to signals received from sensors in communication with the amusement ride. New claim 35 defines the censoring of the received sequences. New claim 36 includes the audio

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source limitation set forth in previous claim 1, and new claim 37 defines the "switch" in claim 1 as a limit switch.

Claims 4, 6-12, 18, and 26-27 depend either directly or indirectly from and add further limitations to independent claim 1 and are believed to be allowable for the reasons discussed hereinabove in connection with independent claim 1. Claims 29 and 31-35 depend either directly or indirectly from and add further limitations to independent claim 28 and are believed to be allowable for the reasons discussed hereinabove in connection with independent claim 28.

Additionally, attached hereto and incorporated herein by reference is a *Declaration Under 37 C.F.R. § 1.132*, executed by Mr. Catanoso attesting to the commercial success of the present invention in conjunction with various amusement park rides. The requisite nexus, between the claimed invention and the commercial success, is evidenced by ¶ 7 in the *Declaration Under 37 C.F.R. § 1.132*.

Therefore, for all these reasons, reconsideration of the Examiner's rejections and allowance of the aforementioned claims are respectfully requested.

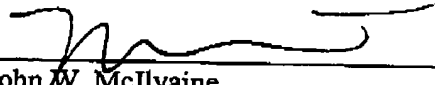
CONCLUSION

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1, 4, 6-12, 18, and 26-29, 31-32, and 35-37 are respectfully requested.

Respectfully submitted,

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